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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,416	12/13/2005	Arianna Benetti	LSP-1016US	5497

87627 7590 01/21/2010

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EXAMINER	
MERCIER, MELISSA S	

ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
01/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,416	BENETTI ET AL.	
	Examiner	Art Unit	
	MELISSA S. MERCIER	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11-12-09*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-22 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-22 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12-31-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

Applicant's claim of priority to US Provisional Application 60/597256 filed on November 18, 2005 is acknowledged.

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed on December 31, 2005 is acknowledged. A signed copy is attached to this office action.

Election/Restrictions

The Examiner acknowledges the incorrect set of claims was utilized for restriction requirement. The Examiner thanks Applicant for bringing it to her attention during the telephone call on November 12, 2009 and making preliminary election of amended group III. In order to clarify the record, the amended restriction requirement is:

Group I, claim(s) 16-22, drawn to an inverse emulsion.

Group II, claim(s) 23-29, drawn to a method of making an inverse emulsion.

Group III, claim(s) 30, drawn to a method of using an inverse emulsion.

Applicant has provisionally elected group III. However, Applicant has also cancelled claims 16 and 23-29 and amended claims 17-22 to depend from claim 30. Therefore, claims 17-22 and claim 30 are therefore pending in this application and are under prosecution. Because applicant did not distinctly and specifically point out the

supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-22 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner notes that the claims are directed to a method of using an inverse emulsion in a cosmetic composition. The body of the independent claim following the term "wherein" does not further clarify if the limitations are related to the emulsion as a whole, the product, or any additional element contained within the emulsion as a whole. Examiner is not clear if the weight ratio is relative to the inverse emulsion as a whole, or the product resultant from the admixing. It is also unclear if the anionic acrylic polymer is required to be polymerized or not, as the claim uses the phrase "obtained by". Furthermore, Examiner is not clear if the concentration of acrylic monomer is relative to the weight of the emulsion as a whole or the product within the emulsion. Clarification is required.

The term "strongly acidic" is a relative term which renders the claim indefinite. The term "strongly acidic" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art

would not be reasonably apprised of the scope of the invention. It is unclear what is considered to be strongly acidic and what is not as no point of reference is cited. Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17-22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung et al. (US Patent 5,721,313) in view of Fillipo et al. (US Patent 5,169,540).

Yeung discloses polymer emulsions formed by inverse polymerization reactions. The polymer is a reaction product of:

(a) an ethylenically unsaturated carboxylate having between about 3 and about 6 carbon atoms;

(b) an ethylenically unsaturated monomer which is nonionic in nature;

(c) an ethylenically unsaturated monomer containing one or more sulfonate or sulfoalkyl groups;

(d) an ethylenically unsaturated monomer having surface active properties; and

(e) a crosslinking agent is provided wherein:

(a) can be acrylic acid or methacrylic acid in the amount of 50-90%,

(c) can be 2-acrylamido-2-methylpropanesulfonic acid (AMPS) in the amount of 1-20%, and

(e) can be methylenebisacrylamide in the amount of 0.01-5.0%.

The polymer composition can be utilized in a cosmetic composition (column 1, lines 60-64).

The emulsions are water in oil emulsions (abstract). The oil phase can comprise hydrocarbon solvents, such as mineral oils (column 4, lines 13-30). The examples

disclose the preparation of numerous emulsions obtained with varying amounts of each component utilized.

Yeung does not disclose the use of a cationic acrylic monomer.

Fillipo disclose inverse emulsions comprising cationic monomers commonly copolymerized with acrylamide including acryloyloxyethyltrimethylammonium chloride and methyacryloyloxyethyltrimethylammonium chloride (column 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the polymers of Fillipo since it is disclosed the cationic monomers provide stable blends.

Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See In re Aller, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615